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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,167	02/05/2002	Terrance D. Peabody	IOI-389	8049

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT PAPER NUMBER

3736

5

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/068,167

Applicant(s)

PEABODY ET AL.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____                                                 |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> .                                                                   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship of each inventor.

It does not identify the post office address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

### *Specification*

2. The disclosure is objected to because of the following informalities:
  - a. On page 8, line 2, --plate-- apparently should be inserted following "stop".
  - b. On page 8, line 7, "138" apparently should read --132--.

Appropriate correction is required.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: in line 3, --adapted-- apparently should be inserted following "guide". Appropriate correction is required.

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4. Claim 6 is objected to because of the following informalities: in line 2, "84(, 90(, and 96(" apparently should read --84°, 90°, and 96°--. Appropriate correction is required.

5. Claim 18 is objected to because of the following informalities: in line 2, "84(, 90(, and 96(" apparently should read --84°, 90°, and 96°--. Appropriate correction is required.

6. Claim 25 is objected to because of the following informalities: in line 2, "it" apparently should read --the stop plate--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5, 6 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase "may be" renders the claim indefinite because it is unclear whether the stop plate is locked at desired angles with respect to the ruler or if the stop plate is merely capable of being locked at angles with respect to the ruler. This rejection can be overcome by amending "may" to read --is adapted to--.

Claim 32 recites the limitation "the means for marking" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is no means for marking recited in the

claims prior to this recitation. This rejection can be overcome by inserting --guiding the-- before "marking" in line 1 of the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 7, 19-23, 26-30, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Engelbrech ('993). Engelbrecht teaches a bone length measurement apparatus for assisting in locating a prosthetic device during an orthopedic procedure. The apparatus includes a marking guide **28** to facilitate marking of a bone tissue at a desired location; a stop plate **3**; a ruler **2** coupled to the marking guide and to the stop plate; and a locking mechanism **18** that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate. The marking guide and the stop plate are utilized in a manner noninvasive to the bone tissue. The locking mechanism **18** includes an opening through which the ruler is received and a release mechanism **20** to selectively release the ruler for sliding movement through the opening. The marking guide **4** is configured to abut a side of the desired bone member, such as a tibia or a pair of distal femoral condyles. In operation, a selected distance between the noninvasive stop plate and the noninvasive marking guide movably coupled to the stop plate is set; the noninvasive stop plate is abutted against an end of a member to be measured; and the noninvasive marking guide is placed along bone tissue of the member for

marking of the bone tissue at the selected distance from the stop plate. The bone tissue is marked and the apparatus is then lifted from the bone member. Bone tissue from the member is then removed in an oncological procedure, or alternatively, a revision procedure is then performed. The setting step includes changing the position of the noninvasive stop plate relative to the noninvasive marking guide along a ruler by sliding the noninvasive marking guide relative to the ruler.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-6, 10-18, 24, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelbrech ('993) in view of Dale et al. ('619). Engelbrech, as discussed hereinabove, teaches all of the limitations of the claims except that the stop plate is pivotally mounted to the ruler and is lockable with respect thereto. Dale et al. teach an osteotomy guide. The osteotomy guide includes a guide assembly **20** to facilitate marking or cutting of a bone tissue at a desired location; a stop member **140,70,150**; a ruler **30** coupled to the marking guide and to the stop plate; a locking mechanism **120** that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate; and a handle **130** coupled to the locking mechanism. The arms/plates of the stop member are pivotally mounted

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with respect to the ruler to facilitate placement against a bone end, and may be locked at desired angles relative to the ruler including approximately 84°, 90° and 96°. It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to form the stop plate of an measuring device similar to that of Engelbrech so that the stop member is pivotable with respect to the ruler in view of the teachings of Dale et al. in order to facilitate a desired placement of the stop plate against a bone end.

13. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelbrech ('993) in view of Kim ('891). Engelbrech teaches all of the limitations of the claims except that the ruler includes a flat side and a series of periodic grooves, and that the release mechanism includes at least one corresponding protrusion to engage selected grooves. Kim teaches a measurement device including a pair of arms 50, a ruler 114 comprising a flat side and a series of periodic grooves 88 coupled to the arms, a locking mechanism 90 and a handle 58 coupled to the locking mechanism. The locking mechanism includes an opening 64 through which the ruler is received and a release mechanism to selectively release the ruler for sliding movement through the opening. The release mechanism includes at least one protrusion 92 for engaging selected grooves and a lever 94 permitting selective engagement and disengagement of the release mechanism and the ruler. It would have been an obvious matter of design choice at the time Applicant's invention was made to form the ruler and locking mechanism of a measuring device similar to that of Engelbrech as a flat ruler having a plurality of grooves and a locking mechanism configured similar to those taught by Kim, since Applicant has not disclosed that having a ruler with a flat side and a plurality of grooves solves any stated problem or is for

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any particular purpose, and it appears that the measuring device would perform equally well with a ruler having a flat side with a plurality of grooves and a corresponding locking mechanism as it would with a cylindrical ruler and a corresponding locking mechanism.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jean-Louis et al. ('224) teaches a surgical marker and a measuring device using such a marker. Anderson et al. ('507) teaches a leg length gauge for total hip surgery. Kondrat ('269) teaches an osteologic measuring device. Gerhardt ('162) teaches a scoliosis measurement member including an elongate scale and adjustable legs.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on (703) 308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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March 18, 2004